



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/032,893	02/27/1998	JOHN O. BIESER	41824B	1428

23859 7590 05/03/2007
NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
----------	--------------

1771

MAIL DATE	DELIVERY MODE
-----------	---------------

05/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/032,893

Applicant(s)

BIESER ET AL.

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/05/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-12,15 and 16 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Request for Reconsideration

1. Applicant's Current Listing of Claims and Remarks filed April 5, 2007, have been entered. No actual amendments have been made to the claims. Claims 2, 7, 8, 13, and 14 have been cancelled. Thus, the pending claims are 1, 3-6, 9-12, and 15-17.
2. Applicant's traverses the obviousness rejections based upon Parikh 2003 (US 2003/0119974) set forth in sections 7 and 9 of the last Office Action by submitting a statement of co-assignment according to 35 USC 103(c) (Remarks, page 5, 3rd paragraph – page 6, 1st paragraph). As such, said rejections are hereby withdrawn.
3. Additionally, applicant's statement of co-assignment of the present invention and the invention of Dibbern (US 6,472,042) according to 35 USC 103(c) (Response, page 8, 1st paragraph – paragraph spanning pages 8-9) is sufficient to withdraw the rejections based upon said Dibbern patent. In particular, the rejection of claim 17 as set forth in section 9 of the last Office Action is hereby withdrawn.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 3-6, 9-12, 15, and 16 stand rejected over US 5,545,276 issued to Higgins and US 5,240,530 issued to Fink in view of US 5,272,236 and US 5,278,272 issued to Lai et al. for the reasons of record since applicant has not amended the claims.

Response to Arguments

6. Applicant's arguments filed with the response of 04/05/07, have been fully considered but they are not persuasive.

7. Applicant traverses the rejection based upon Higgins and Fink in view of the Lai patents by asserting, "The instant rejection is a hindsight reconstruction of the art and is based upon a selective reading of Fink." (Response, paragraph spanning pages 6-7.) Specifically, applicant asserts that relying upon the teachings of the Background section of the Fink reference and ignoring the full teachings of Fink's invention is improper (Response, paragraph spanning pages 6-7). Applicant argues that while the examiner cites Fink's teaching of known characteristics of known hot melt adhesives, "the Office Action fails...to mention Fink's subsequent teaching that carpets comprising these 'conventional' hot melt adhesives exhibit several disadvantages" (Response, 1st paragraph, page 7).

8. In response, it is first asserted that the prior Office Actions did not ignore the full teachings of the Fink reference. Note section 30, page 14 of the Office Action mailed 01/20/06, which states the following:

With respect to the rejection over Higgins and Fink in view of the Lai patents, applicant traverses the rejection by asserting Fink teaches "'conventional' hot melt adhesive do not work as adhesive backcoats" (Amendment, page 21, section C, 2nd paragraph). To the contrary, Fink discloses hot melt adhesives are known in the art as adhesive backcoats and teaches requirements of said adhesive that render it suitable for backcoats (e.g., activation temperature, low enough viscosity, etc.). Fink also explicit cites other patents that employ hot melt adhesive backcoats (col. 2, line 65-col. 3, line 46). Fink does admit that there are problems with some hot melt adhesive backcoats (col. 3, lines 47-68), but this is no way a teaching that "'conventional' hot melt adhesive do not work as adhesive backcoats."

Art Unit: 1771

9. Secondly, it is asserted the rejection is proper in that the Fink reference teaches what is known in the prior art, including the fact that it is known that “conventional” hot melt adhesives have certain disadvantages. “The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). Additionally, Fink’s teaching that “conventional” hot melt adhesives have several disadvantages, including the inability to manufacture recyclable carpets and carpets having consistently reproducible tuft pull strengths, is actual motivation to substitute the another adhesive composition, such as that of the Lai patents, for the “conventional” hot melt adhesive.

10. Applicant also asserts that even if one would be motivated to substitute the compositions of Lai for the Fink hot melt adhesive, the teachings of Fink would suggest that the composition be at least integrally fused to the primary backing material, which is contrary to the present claims (Response, paragraph spanning pages 7-8). However, as argued above, a reference is available for all that it teaches and not just what the patentees describe as their own inventions or to the problems with which they are concerned. While Fink teaches integral fusion of the hot melt adhesive with the primary backing is part of the inventive concept, the reference also inherently teaches that “conventional” hot melt adhesives were not integrally fused. Therefore, applicant’s arguments are found unpersuasive and the above rejection stands.

Allowable Subject Matter

11. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The only prior art references of record which teach or suggest a secondary carpet backing comprising at least one homogeneously branched ethylene polymer (HBEP) having a SCDBI of greater than or equal to 50% are US 5,741,594 issued to Jialanella and US 6,472,042 issued to Dibbern. Since applicant has overcome both the Jialanella and Dibbern references with statements of co-assignment according to 35 USC 103(c) (Remarks filed 07/24/06 and 04/05/07), claim 17 contains allowable subject matter.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

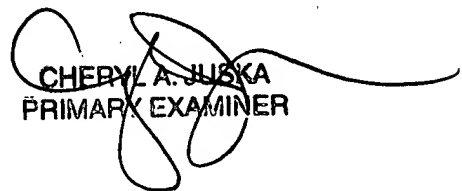
13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the

Art Unit: 1771

examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
April 24, 2007